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EXAMINER

SHAKERI, HADI

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 05/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-5

<b>Office Action Summary</b>	<b>Application No.</b> 09/841,570	<b>Applicant(s)</b> BOCCADUTRE ET AL.	
	<b>Examiner</b> Hadi Shakeri	<b>Art Unit</b> 3723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the motor contained in the handle must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated, per Applicant's disclosure, lines 135 and 136. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: line 110 and 113, drive shaft "201" should be changed to, --202--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 3-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

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which it is most nearly connected, to make and/or use the invention. A removable ratchet extension shaft and a plurality of extensions and shafts, or a extension shaft "fixedly" attached to ratchet handle or the head as claimed is not supported by the specification as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: the relationship between, e.g., ratchet extension and the ratchet extension shaft.

7. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: elements making the tool a "power assisted lever arm ratchet", e.g., in claim 11, what makes the tool a "ratchet extension"?

While the Examiner might speculate as to what is meant by the claim language, the uncertainty provides the Examiner with no proper basis for making the comparison between that which is claimed and the prior art. Rejections under 35 U.S.C. § 103 should not be based upon considerable speculation as to the meaning of terms employed and assumptions as to the scope of the claims. *In re Steele*, 134 USPQ 292. When no reasonably definite meaning can be ascribed to certain terms in a claim, the subject matter does not become obvious, but rather the claim becomes indefinite. However, in an attempt to expedite the process, prior art is applied to claims *as best understood*.

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**Claim Rejections - 35 USC § 102**

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 3, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Lampke, US Patent No. 2,808,749.

Lampke discloses all the limitations of claims 1 and 11, i.e., power wrench comprising a handle containing a motor; a ratchet extension, (41); a ratchet extension shaft (55); and a ratchet head (1).

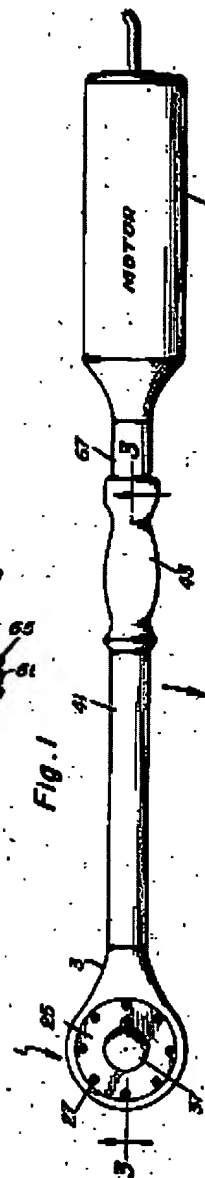
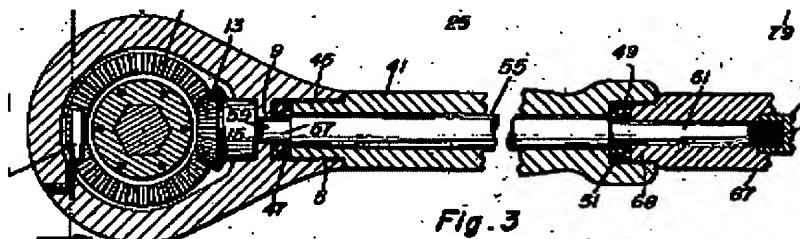
Regarding claim 3,  
wherein the extension and  
shaft are removable.

Regarding claims 7

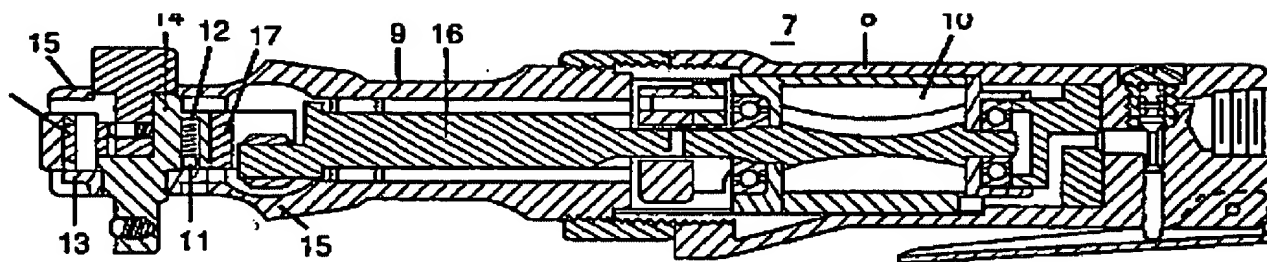
and 9, wherein the heads and the handle are removable, and the extension and the shaft are “fixedly” attached to the handle and head respectively (fixedly is considered as a fixed attachment and not “unitary”).

10. Claims 1, 3, 7, 9 and 11 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's Admitted Prior Art (AAPA).

As admitted by Applicant, lines 135 and 136, a power ratchet wrench as shown in Fig. 3 is old, thus meeting the claims limitations as explained above.



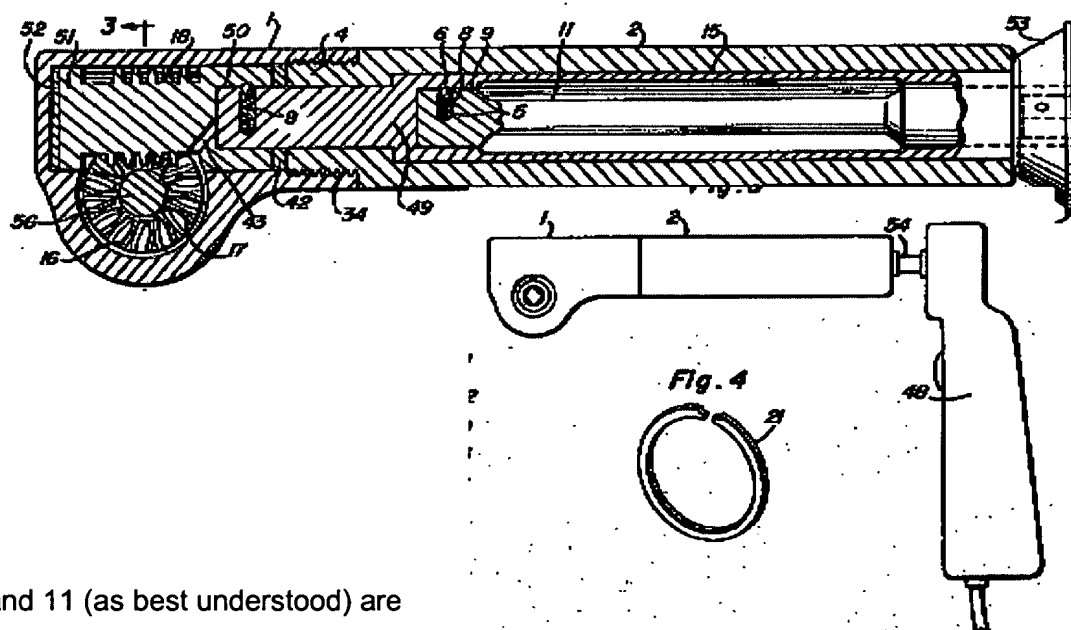
**11.** Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by D' Haem et al., US Patent No. 4,791,836.



D'Haem et al. clearly anticipates claim 1, e.g., Fig. 2.

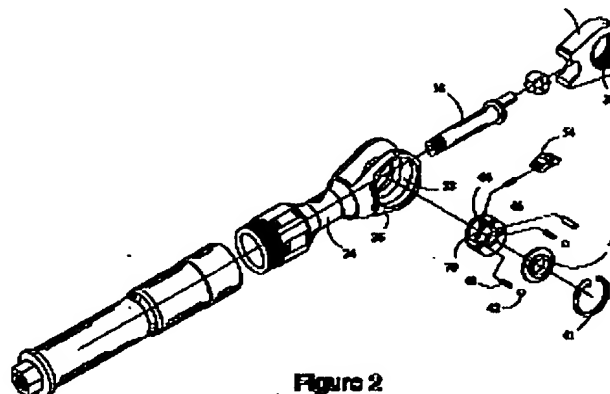
12. Claim 11 is rejected under 35 U.S.C. 102(b) as being clearly anticipated Hendrickson, US Patent No. 3,430,510.

Hendrickson  
clearly anticipates  
claim 1, e.g., Figs. 2  
and 5.



**13.** Claims 1, 3, 7, 9 and 11 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Pijanowski, US Patent No. 5,967,002.

Pijanowski anticipates the above claims as best understood, i.e., a handle (23), a head removable from the handle, an extension and an extension shaft (23).



### Figure 2

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**Claim Rejections - 35 USC § 103**

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

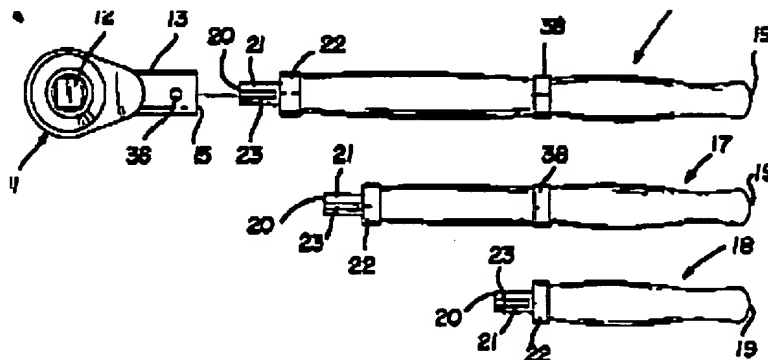
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2, 4, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Lampke, AAPA, D' Haem et al., Hendrickson and Pijanowski.

Each of above mentioned prior art meets the limitations of the above claims except for disclosing an extension and a shaft having a length between 6 to thirty inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an extension and a corresponding shaft having a length or approximately 6-30", since it has been held that changing shape, dependent on work-piece parameters, involves only routine skill in the art. *In re Stevens*, 101 US PQ 284(CCPA1954).

16. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampke.

Lampke discloses an extension (41) and a drive shaft (55) meeting the limitations of the above claims except for disclosing a plurality of extensions and an extension and a shaft having a length between 6 to thirty inches. Bogli teaches a detachable handle for ratchet wrench including a plurality of different sized extensions.



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It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of Lampke with plurality of extensions as taught by Bogli permitting the user to change the handles to suite the needs of the user.


Regarding claim 6, Lampke in view of Bogli meets the limitations, Bogli, col. 6, line 5.

### ***Conclusion***

17. Prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Frenkel, Holmin et al., Gala, Roth, Bollinger and Mann are cited to show related inventions.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. Official documents may be faxed to (703) 872-9302, after final to (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.

  
HADI SHAKERI  
PATENT EXAMINER

May 20, 2003